

REMARKS / DISCUSSION OF ISSUES

Claims 1, 3-18 and 20-27 are pending in the application. Claims 1 and 18 are independent claims.

Unless indicated to the contrary, claims are amended to replace European-style phraseology with phraseology more suitable for US practice. No new matter is submitted through amendments/new claims.

Allowable Subject Matter

Applicants gratefully acknowledge the indication of allowability of claims 2,5,8 and 11-14. The subject matter of claim 2 has been incorporated into claim 1, and thus claim 1 and the claims that depend therefrom are patentable over the applied art.

Applicants gratefully acknowledge the indication of allowability of the subject matter of claims 19 and 23-26 over art, and for at least the reasons discussed below, Applicants submit that these claims are in condition for allowance as well.

Applicants acknowledge the reasons for allowance provided by the Examiner. Applicants reserve their right to address these reasons in future correspondence.

Rejections Under 35 U.S.C. § 102

The rejections under this section of the Code have been considered. While Applicants in no way concur the propriety of the rejection of claims 1, 3-4, 6-7, 18, 20 and 22, based on the amendments provided, this rejection moot.

Rejections under 35 U.S.C. § 101

The Office Action rejects claims 18-26 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Applicants respectfully traverse these rejections for at least the following reasons.

The Office Action states that:

The claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). The language in the claim suggest only a combination of instructions and lacks a tangible result at the end of the procedure.

The USPTO Official Gazette Notice dated 22 November 2005, entitled "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" ("the OG Notice") merely contains guidelines for patent examiners, and like the MPEP, does not have the full force and effect of law (see the OG Notice, Section I, second paragraph). This notwithstanding, the undersigned attorney has thoroughly reviewed these guidelines and respectfully submits that the rejections of claims 1-14 are not compliant with those guidelines.

At the outset, Section IV of the OG Notice explains in detail the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. The only references to "tangible results" in this procedure appear under Step IV(C) – "*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*" Not surprisingly, the first thing the Examiner must do under Step IV(C) is to "*determine whether [a claim] covers either a Sec. 101 judicial exception or a practical application of a Sec. 101 judicial exception.*" Only if such a determination is made, does the analysis then proceed to determine if the claimed subject matter is nevertheless still patentable subject matter, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

Here, the Office Action does not ever attempt to determine whether any or all of claims 18-26 cover either a Sec. 101 judicial exception (Law of Nature, Natural Phenomenon, or Abstract Idea) or a practical application of a Sec. 101 judicial exception.

Rather, the claims are dismissed as abstract ideas with no analysis or explanation supporting this position. Indeed, Applicant respectfully submits that none of the claims 18-26 cover any law of nature, natural phenomenon, or abstract idea.

Claims 18-26 are all directed toward a method for performing on-chip magnetic resonance measurements,. These methods do not cover any law of nature, natural phenomenon, or abstract idea. Accordingly, the entire analysis as to where the claims “*produce a tangible result*” is not even pertinent under the Guidelines, because the claims are not even directed to any Sec. 101 judicial exception in the first place.

Furthermore, even *if* any of the claims 18-26 were directed to a Sec. 101 judicial exception, the Guidelines specifically state that this does not mean that the claim must be tied to a particular machine or apparatus. So there can be no requirement that the “result” of the claimed process must be stored or displayed. Furthermore, the OG Notice defines “tangible” as being the opposite of “abstract.” All that is required is that the claim must set forth a practical application to produce a real-world result. Here, the claims all are practical applications producing the real-world result. The claims all include tangible and concrete result of on-chip detecting of spin magnetic moments precession. Accordingly, assuming arguendo that claims 18-26 were directed to a Sec. 101 judicial exception, the final result at the very least is a tangible result, particularly to those requiring inspecting of certain objects, such as.

Accordingly, for at least these reasons, Applicants respectfully submit that claims 18-26 are all patentable under 35 U.S.C. § 101.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number

50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos, Esq./
by: William S. Francos (Reg. No. 38,456)
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